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Paper No. 14

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MAR 10 1995

In re Application of
Carol A. Westbrook
Application No. 07/784,222
Filed: October 28, 1991
Attorney Docket No. ARCD:010/UCH

OFFICE OF THE
A/C DATE
ON PETITION

This is a decision on the petition, filed May 23, 1994, under 37 CFR 1.181 to withdraw the holding of abandonment, or in the alternative, under 37 CFR 1.137(b) to revive the above-identified application.

The petitions are dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181 to withdraw the holding of abandonment or 37 CFR 1.137(b)."

This application became abandoned for failure to respond in a timely manner to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (Notice) mailed April 15, 1992. The Notice set a period for response of one (1) month from the mail date. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on May 16, 1992.

Petitioner asserts that a response to the Notice of April 15, 1992 was filed by facsimile on August 6, 1992. Petitioner further asserts that during a telephone conversation with an examiner, the examiner indicated that a sequence disclosure was not necessary in this application.

A review of the application file does not reveal the communication or "response" purported to have been filed by facsimile on August 6, 1992. Petitioner should provide a statement in compliance with 37 CFR 1.8(b) attesting on a

personal knowledge basis to the transmission of this communication on August 6, 1992.

Petitioner acknowledges that pages 37 and 38 of the specification contain sequence information, and, as such, a sequence disclosure in compliance with 37 CFR 1.821 *et seq.* is required in this application (petition of May 23, 1994 at 6). Initially, it is noted that any "response" to the Notice of April 15, 1992 filed on August 6, 1992, even if a complete and proper response to such Notice, was untimely as submitted outside the period for response to such Notice. In addition, the "response" purported to have been filed by facsimile on August 6, 1992 does not constitute the response required by the Notice of April 15, 1992, *i.e.*, a sequence listing in compliance with 37 CFR 1.821 *et seq.* Accordingly, the filing of this communication or "response" on August 6, 1992 would not have been effective to avoid the abandonment of this application, and petitioner's contention that such communication or "response" was in fact filed on August 6, 1992 is immaterial to the abandoned status of this application.

While petitioner believed that a sequence listing was not required in this application, there is no showing that this application was not properly held abandoned for failure to submit a sequence listing in accordance with the requirements of the Notice. Whether petitioner was informed during telephone conversations in May and June of 1993 that a sequence listing in accordance with the Notice was not required, it is well established that an applicant relies upon oral advice at his or her own risk. 37 CFR 1.2. In addition, this oral advice was inconsistent with the Notice of April 15, 1992, *i.e.*, the written communication from the Office concerning this application. As petitioner relied upon the oral advice of Office personnel, which advice was contrary to the written communication from the Office concerning this application, petitioner must bear the risk that such advice was inaccurate. B and E Sales Co v. Andrew Jergens Co., 7 USPQ2d 1906, 1907 (Comm'r Pat. 1988); In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

With regard to the petition under 37 CFR 1.137(b), as the petition has not been filed within one (1) of the date of abandonment or within three (3) months of the date of the first decision to revive under 37 CFR 1.137(a) which was filed within one (1) year of abandonment of this application, the petition is dismissed as untimely.

Petitioner should consider filing a petition under 37 CFR 1.137(a) requesting revival of the above-identified application.

Any petition under 37 CFR 1.137(a) must be accompanied by the petition fee required by 37 CFR 1.17(1), an adequate verified


showing of the cause of unavoidable delay, and a terminal disclaimer and terminal disclaimer fee of \$110. Specifically, a disclaimer of a terminal portion of any patent which may issue on the above-identified application or on any application entitled to the benefit of the filing date of this application under 35 USC 120 would be required. The period to be disclaimed would be a terminal part of the patent to be granted equivalent to the period of abandonment. The period of abandonment will be computed to be the number of months lapsed from the date of abandonment to the date of filing a grantable petition. If the terminal disclaimer is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.


Robert W. Bahr
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachments: Terminal Disclaimer Form
Certificate Under 37 CFR 3.73(b)